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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

HSU, G

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

04/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/122,576

Applicant(s)

Siev et al.

Examiner

Grace Hsu, Ph.D.

Group Art Unit

1627



☒ Responsive to communication(s) filed on Jan 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27, 29-32, 34-76, 78-101, and 103-116 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-27, 29-32, 34-76, 78-101, and 103-116 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Keith Macmillan, Supervisory Examiner at Keith.MacMillan @uspto.gov or 703-308-4614. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The Response to December 21, 1999 Restriction Requirement was received on January 24, 2000 and entered as Paper No. 8.
2. Claims 1-27, 29-32, 34-76, 78-101 and 103-116 are currently pending and claims 28, 33, 77 and 102 are withdrawn from further consideration by the Examiner under 37 CFR 1.142(b), as being drawn to non-elected inventions, the requirement not traversed in Paper No. 8.
3. Applicants' election of Group I, without traverse, for examination purposes is acknowledged. However, in the interest of compact prosecution, a new restriction requirement of the claims of elected Group I of the instant application has been set forth below.

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27 and 29-31, drawn to a method for the production of a derivatized resin represented by formula (I), $R_4-NH-(C=X)-Y-Z-SS$, is prepared by a process comprising steps (i) and (ii), wherein step (i) involves reacting a **starting material (C)**, $R_1-(C=X)-Y-Z-SS$, with a **reactant of formula (D)**, R_4-NH_2 , classified in

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- class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.
- II. Claims 32 and 37-48 and 54-55, drawn to a method for the production of a derivatized resin represented by formula (I), $R_4-NH-(C=X)-Y-Z-SS$, is prepared by a process comprising the steps (i) and (iii), wherein step (i) involves reacting a **starting material (E)**, $R_4-NH-(C=X)-R_2$ (wherein R_2 is a leaving group), with a **reactant of formula (A)**, $R-Y-Z-SS$ (wherein R is a leaving group), classified in class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.
- III. Claims 56-76 and 78, drawn to a method for the production of a derivatized resin represented by formula (I), $R_4-NH-(C=X)-Y-Z-SS$, which is prepared by a process comprising the steps of (i) and (ii), wherein step (i) involves reacting a **starting material (AA)**, $R_4-N=C=X$, with an **anion of formula (BB)**, $(-)Y-Z-SS$ and quenching the reaction with a proton source, classified in class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.
- IV. Claims 79-101 and 103-105, drawn to a method for the production of a derivatized resin represented by **formula (IA)**, $R_4-NH-(C=X)-NH-Z-SS$, is prepared by a process comprising the steps of (i) and (ii), wherein step (i) involves reacting a **starting material (G)**, $T-Z-SS$, with a **reactant of formula $R_4-NH-(C=X)-NH-Q$** , to form the recovering the derivatized resin (IA), classified in class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.
- V. Claims 106-111, drawn to a method for the preparing a derivatized resin, which comprises steps: (i)-(iii), classified in class 436, subclass 85 and in other

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classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.

- VI. Claims 111-115, drawn to a method for the preparing a derivatized resin, which comprises steps: (i)-(iv), classified in class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.
- VII. Claims 116, drawn to a method for the production of an hydroxamic ester, which comprises a solid support of formula (I), said method comprising steps (i)-(iii), wherein step (i) involves reacting a starting material (C), $R1-(C=X)-Y-Z-SS$, with a reactant of formula (D'), $R4'-NH_2$, to form the derivatized resin, classified in class 436, subclass 85 and in other classes/subclasses, which will vary depending on the choice substituents of each starting material, reagent and products.

5. The inventions are distinct, each from the other, because of the following reasons:

6. Groups I-VII represent separate and distinct inventions. Groups I-VII are drawn to different methods or process (which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s) or lead to different final results). Therefore, Groups I-VII have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

7. These inventions are distinct for the reasons above and have acquired a separate status in the art because of their recognized divergent subject matter and/or shown by their different classifications. While some of the aforementioned groups are classified under an identical

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class/sub-class, the corresponding non-patent literature search remains unaffected. Each of the identified groups may require different searches. For example, method and product groups require different searches. Therefore, restriction for examination purposes as indicated is proper.

8. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

For search purposes, applicants should provide the chemical structure of each patentably distinct species of whichever invention of Groups I-VII is elected for examination, wherein specific chemical formula substituents of those species are defined either by picture or by expressing the species in terms of each of the variables of each respective formula of products, starting materials and/or reactants.

For example, if applicants elect the invention of **Group I**, applicants are required to provide the chemical structure of a patentably distinct species as defined by each of the functional group variables set forth on a resin of formula (I), $R_4-NH-(C=X)-Y-Z-SS$. In the instant case, many potential species of resins of formula (I) are encompassed by the aforementioned formula depending upon the choice of functional group variables, each of which involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

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9. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 6:00 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Keith MacMillan may be reached at (703) 308-0570. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

**BENNETT CELSA
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Bennett Celsa', written over the printed name.

Grace C. Hsu, Ph.D.
April 9, 2000